

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

I. Introduction

Claims 1, 8, 17, 24, 94, 114, 115, 119, 133 and 134 have been elected for examination. Non-elected dependent claims 2-7, 18-23, 95-100, 105-113, 116-118, 124-132, 135-137, and 141-143 are withdrawn from consideration. Applicants respectfully request that these dependent claims be rejoined with the independent claim from which they depend upon the allowance of the respective independent claim(s).

Claims 101-104, 120-123, and 138-140, and non-elected claims 9-16, 25-93, 144-151 are cancelled without prejudice or disclaimer to present these claims in a divisional application. Claims 1-8, 17-24, 94-100, 105-119, 124-137, and 141-143 remain pending in this application.

Claims 1, 17, 94 and 119 are amended to change the term “not more than 8 diametral lattice planes” to “not more than 10 diametral lattice planes”. Claims 6 and 22 are amended to change “not more than 7 diametral lattice planes” to “not more than 3 diametral lattice planes”. The specification has also been amended to add the “not more than 10 diametral lattice planes” on page 13, line 13.

Support for this amendment may be found on page 13, lines 7-21 of the present specification and on page 6, line 16 and in claim 6 on page 36 of the priority provisional application serial number 60/393,835 filed on 7/8/02, which is incorporated by reference on page 1 of the present application. Specifically, the provisional application discloses the “not more than 10 diameter lattice planes” limitation on page 6, line 16. The provisional application also discloses the 1-3 lattice plane limitation in claim 6 on page 36. The “not more than 10 diameter lattice planes” limitation has been added to the claims and

specification of the present application from the priority provisional application which was incorporated by reference into the present application. No new matter was added.

II. Interview Summary

Applicants appreciate the courtesy extended by Examiner Jackson in conducting a telephone interview with the undersigned representative on November 30, 2006. During the interview, the examiner pointed out that the previously filed Rule 132 Declaration was insufficient because it did not expressly state that the co-authors of the Bjork et al. Nano Letters article other than Samuelson and Ohlsson did not invent the subject matter of the article that was relied upon in the rejection of the claims. It was agreed that applicants would submit a new declaration which expressly states this.

The examiner indicated that applicants could amend claims 1, 17, 94 and 119 to recite “not more than 10 diametral lattice planes” instead of “not more than 8 diametral lattice planes”, as provided in the priority provisional application serial number 60/393,835 filed on 7/8/02. After the amendment, the priority provisional application would support these claims under section 112 and these claims would be granted benefit of the 7/8/02 filing date of the provisional. This would render the Bjork et al. article at best section 102(a) prior art instead section of 102(b) prior art. Therefore, the new Rule 132 Declaration would be sufficient to overcome the rejections based on the Bjork et al. article. Applicants representative agreed to amend the claims as suggested.

III. The Rejections Should Be Withdrawn

Claims 1, 8, 17, 24, 94, 114, 115, 119, 133 and 134 have been rejected under 35 USC 102(b) or 103(a) over Bjork et al. (Nano Letters 2002 article). Claims 1, 8, 17, 24, 94, 114, 115, 119, 133 and 134 have been rejected under 35 USC 103(a) over Bjork et al. (Nano Letters 2002 article) in view of Ohlsson (APL 2001 article).

Claims 1, 17, 94 and 119 have been amended to recite “not more than 10 diametral lattice planes” instead of “not more than 8 diametral lattice planes”. Thus, the priority provisional application serial number 60/393,835 filed on 7/8/02 now supports these claims

under section 112 and these claims now have an effective filing date of 7/8/02. This renders the Bjork et al. article at best section 102(a) prior art instead of section 102(b) prior art.

As noted in MPEP 715.01(c)(I), "... the applicant may overcome the [section 102(a)] rejection by filing a specific affidavit or declaration under 37 CFR 1.132 establishing that the article is describing applicant's own work. An affidavit or declaration by applicant alone indicating that applicant is the sole inventor and that the others were merely working under his or her direction is sufficient to remove the publication as a reference under 35 U.S.C. 102(a). *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982)."

Applicants submit a new Rule 132 Declaration by Lars Samuelson and Bjorn Jonas Ohlsson, the co-inventors of the present application, which establishes that the two applicants are the sole inventors of the subject matter in the Bjork et al. article used in the rejections and that the other co-authors were working under their directions and were not inventors of this subject matter. The other co-authors of the article were not inventors of this subject matter. Specifically, Professor K. Deppert of Lund University was responsible for the machine that provided the Au aerosol catalysts for nanowhisker growth. M. Magnusson was a graduate student at Lund University who worked with Professors Samuelson and Deppert. He prepared the Au aerosol catalysts for nanowhisker growth. R. Wallenberg was a microscopist who made micrographs of the nanowhiskers. M. Bjork, A. Persson and C. Thelander were graduate students in Professor Lars Samuelson's group at Lund University who were working under the present inventors' direction with respect to the above subject matter.

Applicants submit that the Declaration is sufficient to remove the Bjork et al. article as prior art under 102(a) because at least the portions of the article used in the rejection describe the applicants' own work. Since the Bjork et al. article is not prior art with respect to the presently claimed invention, applicants respectfully request a withdrawal of the rejections based on this article.

VI. Conclusion

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. The

Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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By 

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